

In the claims:

Please cancel original claims 1 through 7, and replace them with new claims 8 through 37 that are attached as REPLACEMENT PAGES to this document.

REMARKS

Applicant expresses appreciation to the Examiner for the consideration of the subject patent application. The following comments are offered to overcome the rejections cited in the Office Action. A three month extension fee is also enclosed.

In item 3, claims 1-2 and 4-5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Donohue et al. (US Pat No 6,262,717). Specifically, claim 1 is rejected for teaching a touchpad keyboard for entering data into a portable electronic appliance, and having a communications port for transmitting signals corresponding to keys on the touchpad keyboard.

New claim 8 corresponds to rejected claim 1. For a § 102(e) to be successful, the prior art must show each and every claimed element of the invention. Applicant respectfully traverses the rejection of claim 8 as anticipated by Donohue. Claim 8 has been amended to more explicitly describe that the touchpad keyboard is for use with a hand-held and portable electronic appliance. In contrast, Donohue teaches a touchpad for use with a kiosk. A kiosk is not a hand-held and portable electronic appliance as shown in figure 1. Donohue does not suggest or teach a kiosk of any other size or proportions other than the kiosk shown in figure 1. Accordingly, claim 1 cannot be anticipated by Donohue.

As further evidence, it is noted that figure 4 shows that the touchpad has exposed

circuit elements. In contrast, figure 3 of the present invention shows that the touchpad keyboard is a self-contained device 10. The housing of the touchpad keyboard must completely surround the touchpad keyboard and its circuit elements in order to protect them. This is not the case in Donohue.

Applicant also points out that in claim 8, it has been modified to include a communications port for direct coupling to a hand-held and portable electronic appliance and shown in figure 3 of the present invention. In contrast, the communications port cited by the Office Action in Donohue is a wire for remote coupling.

Regarding claim 2, the Office Action asserts that the audio feedback system is also taught by Donohue.

New claim 8 has also been modified to include the subject matter of original claim 2. Applicant respectfully traverses the rejection of claim 8 because Donohue does not teach the claimed concept of a pre-recorded voice speaking and stating the name of the key being touched. Donohue simply states that there is audible feedback to indicate that any key has been touched. In other words, the audible feedback is not specific regarding which of the keys has been touched. Thus, Donohue teaches that a sound, such as a beep or click will be made audible, but does not go so far as to indicate that the specific key will be identified by a human voice. This element is not anticipated by Donohue

Regarding claim 4, the Office Action asserts that Donohue teaches a communications cable coupled to a communication port to thereby enable remote coupling to a portable information appliance.

Applicant respectfully traverses this rejection for several reasons. First, Donohue teaches that the remote coupling is to a main processor, not to a portable information

appliance. A main processor is not the same as a self-contained hand-held portable information appliance. The coupling being claimed is shown in figure 4 of the present invention. Remote coupling is shown by the cable 30, as opposed to the direct coupling shown in figure 3, where no cable is disposed between the self-contained hand-held portable information appliance and the touchpad keyboard.

Regarding claim 5, new claims 15 and 16 claim tactile feedback. Applicant respectfully asserts that these claims are dependent upon an allowable base claim, and are therefore allowable over the prior art.

In item 4, claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Donohue in view of Will (US Pat No 5,825,353). Before addressing the specific obviousness rejection, Applicant wishes to clarify what is required to support an obviousness rejection. The Office Action must establish a prima facie case of obviousness to meet the burden of § 103.

The PTO has the burden under § 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference. (In *Re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted))

In establishing a prima facie case of obviousness, the PTO "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* At 1600. Rather "[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Applicant respectfully traverses the rejection of original claim 3, now new claim 10. Will teaches a scroll wheel for a personal digital assistant. The present invention claims the scroll wheel as an integral component of a touchpad keyboard. This combination is not shown nor suggested in the prior art.

In item 5, claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Donohue.

Applicant respectfully traverses the rejection of original claims 6 and 7, the subject matter now being claimed in new claims 36 and 37. For the reasons given above regarding the rejection of original claim 1 (new claim 8), it is noted again that Donohue never teaches nor suggests that the touchpad keyboard can be implemented in any other device except a kiosk or the size and proportions shown in figure 1. Furthermore, the teachings of Donohue for a touchpad having exposed circuit elements as shown in figure 4 teach away from the concept of a self-contained touchpad keyboard as shown in figures 3 and 4 of the present invention.

If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the Examiner is invited to call David W. O'Bryant at (801 478-0071 so that such matters may be resolved as expeditiously as possible.

xThe Commissioner is hereby authorized to charge any additional fees for the added claims to Deposit Account No. 50-0881.

DATED this 5th day of December, 2002.

Respectfully submitted,



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